

**REMARKS**

This paper is submitted in response to the non-final Office Action dated September 11, 2009 (the “Office Action”).

Claims 1-36 and 40-41 were previously pending in the application. Claims 6, 13, 20, and 34 have been canceled in this paper, and claims 42-45 have been added in this paper.

Accordingly, claims 1-5, 7-12, 14-19, 21-33, 35-36, and 40-45 are now pending.

Claims 1, 7, 9, 14, 16, 21, 23, 30, 35, and 41 have been amended in this paper.

Claim 41 is under objection.

Claims 1-5, 7-12, 14-19, 21-33, 35-36, and 40-41 stand rejected.

The amendments add no new matter. Support for the amendments may be found throughout Applicant’s Specification and Drawings as originally filed, for example in ¶¶10-11, 32, 36, 62, and 73-74. While not conceding that the cited reference(s) qualify as prior art, but instead to expedite prosecution, Applicant has chosen to respond as follows. Applicant reserves the right to establish that the cited reference(s), or other references cited thus far or hereafter, do not qualify as prior art as to an invention embodiment previously, currently, or subsequently claimed. Applicant respectfully submits that the pending claims are allowable in view of the following remarks and the above amendments, and respectfully requests reconsideration of the pending rejections.

**Formal Matters**

Applicant gratefully acknowledges the opportunity provided by the Examiner on September 8, 2009 for a telephonic interview between the Examiner and Applicant’s representative Cyrus Bharucha. During that discussion, the Examiner and Applicant’s representatives discussed, among others, FIGs. 2, 6, and 7 of Wakai and Applicant’s independent claim 1, including various limitations that Applicant believes distinguish over the previously cited references Wakai, Tso, and Iwamoto. Applicant acknowledges the Interview Summary

provided with the Office Action, but respectfully and strongly disagrees with this summary to the extent that it proposes that Applicant believes device 140 in FIG. 1A to be the only novel feature of the present invention. To the contrary, Applicant respectfully submits that the pending claims include a number of limitations, and combinations of limitations, that are absent from the cited passages, whether taken individually or in combination with each other and the knowledge available to a person having ordinary skill in the art.

**Objection to the Claims**

Claim 41 is under objection regarding matters of form. In particular, the Office Action appears to express a concern regarding the use of the label of a “fourth” language, in a claim that does not recite a “third” language. Applicant believes that the label of a “fourth” language adequately and clearly indicates the relevant language, without requiring an antecedent of three other languages.

Nonetheless, to further prosecution, Applicant has amended claim 41 to employ the label of a “third” language. Accordingly, Applicant respectfully requests that the objections be withdrawn.

**Rejection of Claims under 35 U.S.C. § 103(a)**

Claims 1-36 and 40-41 stand rejected under 35 U.S.C. § 103(a) as purportedly being unpatentable over U.S. Patent No. 6,587,126 issued to Wakai, et al. (“**Wakai**”) in view of U.S. Patent No. 6,421,733 issued to Tso, et al. (“**Tso**”), U.S. Patent No. 7,167,919 issued to Iwamoto, et al. (“**Iwamoto**”), and U.S. Patent Publication No. 2004/0030693 by Toda (“**Toda**”).

Applicant respectfully submits that the claims are allowable because a person having ordinary skill in the art would not make the proposed combination of references, and also because even if combined, the cited passages of the references would fail to disclose each limitation of Applicant’s claims.

**A. The cited references do not disclose each limitation of Applicant's claims.**

Without conceding the appropriateness of the cited combination of references, but in an effort to expedite prosecution, Applicant has amended independent claims 1, 9, 16, 23, and 30. Applicant respectfully submits that the pending claims include limitations that are absent from the cited passages.

For example, amended claim 1 recites *selecting a first device* of a plurality of devices, which includes *at least two devices configured to provide the requested service*. The first device is selected to provide the requested service, and the request is converted to a second request that conforms to a request format defined in a second language. Each of the plurality of devices is configured to provide a corresponding service, and at least one of the plurality of devices is configured to receive requests only in a format that is incompatible with the request format defined in the second language. At least these limitations are absent from the cited passages of Wakai, Tso, Iwamoto, and Toda, whether taken individually or in combination.

As noted in the present application, issues of interoperability arise in environments that employ incompatible devices provided by multiple vendors. *See, e.g.*, Application, ¶¶ 2-3, 9. Toda purports to provide an all-in one multifunction peripheral apparatus that includes components for transmitting facsimiles, printing, and scanning. *See, e.g.*, Toda, FIG. 2 and associated discussion. While this approach nominally avoids issues of compatibility, it does so by altogether eliminating flexibility.

Toda's CPU 21 is configured to operate with other components in Toda's multifunction peripheral apparatus (MFP) 2, such as facsimile element 28, printer element 31, and scanner element 32. *See, e.g.*, Toda, ¶¶ 52, 77. The Office Action proposes that the Wakai-Tso-Iwamoto-Toda combination would teach selection of a device, citing a "print command" for Toda's printer element 31. See, Office Action, p. 8. The Office Action also proposes that this selection would be made among a plurality of devices, citing facsimile element 28, printer element 31, and scanner element 32, to provide a requested service. *See, id.* Even if these proposals were correct (a point which Applicant does not concede), the Wakai-Tso-Iwamoto-Toda combination would not teach that *at least two devices among the plurality of devices are configured to provide the requested service*, since the cited elements 28, 31, and 32 of MFP 2 do not include at least two printer elements from which printer element 31 could be selected.

Moreover, a person having ordinary skill in the art would not further modify MFP 2 to have two printers since such redundancy would eviscerate the efficiency of Toda's all-in-one device. In addition, the cited passages do not teach that CPU 21 would be suited for controlling or communicating with any printer elements that are external to MFP 2. Since CPU 21 is internal to Toda's multifunction peripheral apparatus 2, a person having ordinary skill in the art would not adapt CPU 21 for use with such external printer devices. The shortcomings of the Wakai-Tso-Iwamoto-Toda combination would therefore not be remedied by any straightforward modifications, since the cited facsimile element 28, printer element 31, and scanner element 32 in MFP 2 would not reasonably be modified to include at least two printer elements from which printer element 31 could be selected.

A rejection under § 103(a) may establish, among others, that "all the claimed elements were known in the prior art." See MPEP § 2143.02 (citing *KSR International Co. v. Teleflex Inc.*, 550 U.S. \_\_, \_\_, 82 USPQ2d 1385, 1395 (2007)). The pending rejection attempts to meet this standard, but falls short with regard to amended claim 1 because of above-noted failings of the Wakai-Tso-Iwamoto-Toda combination. At least for this reason, independent claim 1 and all claims dependent claims thereon are allowable under § 103(a). At least for similar reasons, independent claims 9, 16, and 23 and all claims dependent therefrom are also allowable under § 103(a).

**B. Modifying Toda's CPU 21 with Tso's parser 22 is counter to the teachings of Toda and Tso.**

Moreover, Applicant respectfully submits that a person having ordinary skill in the art would not make the combination of references as proposed in the Office Action. In the proposed combination, Toda's CPU 21 would need (among others) to be modified so that it operates in response to actions by Tso's language parser 22. A skilled person would not make this modification.

Applicant's independent claim 1 recites providing a request to a *language parser*. The request conforms to a request format defined in a *first language*. The language parser of claim 1 is *configured to parse the first language*. Claim 1 further recites selecting a first device of a *plurality of devices*, and converting the request to a second request that conforms to a request

format defined in a *second language*. The selecting the first device is performed *in response to the obtaining the results of parsing the request*.

The Office Action equates Tso's language parser 22 with the *language parser* recited in Applicant's claim 1. *See* Office Action, p. 6. The Office Action correctly notes, however, that neither Tso, Wakai, nor Iwamoto teach that Tso's language parser 22 is suitable for operation with the *plurality of devices*, in which at least one device is *configured to receive requests only in a format that is incompatible with the request format defined in the second language*. *See* Office Action, p. 8.

With regard to this limitation, the Office Action turns to Toda, and proposes that the *plurality of devices* is met by a facsimile element 28, printer element 31, and scanner element 32 in Toda's MFP 2. *See* Office Action, p. 8. Toda's elements 28, 31, and 32 are connected via a system bus to CPU 21, which purportedly processes commands received through network interface 25. *See* Toda, ¶ 52 (“CPU 21 interprets commands from the PC 1,” and “[i]n response to reception of the commands, . . . performs corresponding operations.”) “CPU 21 . . . causes the printer engine 31 to form an image, the scanner engine 32 to scan a document, and the facsimile communication unit 28 to transmit image information.” *See, id* (emphasis added).

Thus, commands from PC 1 are given effect on the cited elements 28, 31, and 32 through CPU 21, and any selection of the cited elements 28, 31, or 32 would be performed by CPU 21. Applicant's claim 1 recites that *selecting the first device* is performed *in response to the obtaining the results of parsing the request*. In order to meet these limitations, CPU 21 of Toda would need (among others) to be modified so that it operates in response to actions by the cited language parser 22 of Tso.

But Toda purports to teach that CPU 21 is functionally adequate for the needed operations of communicating with and controlling Toda's elements 28, 31, and 32. Accordingly, a person having ordinary skill in the art would see no need to modify CPU 21 as proposed in the Office Action. The Office Action's proposed benefits of “more efficient control of the multi-function device” and “improved compatibility” are altogether unjustified. The Office Action fails to explain how the modification of the already-suitable CPU 21 would achieve more efficient control or improved compatibility with elements 28, 31, or 32 or other features of

MFP 2. Indeed, Toda itself teaches that the system described therein already provides efficient control (*see ¶ 11*) and improved compatibility (*see ¶ 15*).

Moreover, it is not at all clear that Tso's parser 22 would (or even could) improve Toda's CPU 21 in these regards. Parser 22 can be included in a transcoder in a client device. *See* Toda, 3:8-21. "Parser 22," in one embodiment, "selects an appropriate transcode service provider 24 based, for example, on the content type of the data stream. In this context, the term content type encompasses a datatype, an HTTP MIME (Multipurpose Internet Mail Extensions) type, a content format, and so on." Tso, 6:37-41. The additional modules used with parser 22—such as Tso's transcode service provider 24—would add unnecessary and unwieldy overhead to Toda's already efficient CPU 21. Moreover, the content types relevant to parser 22—such as Tso's datatype, HTTP MIME type, or content format—are not described as being usable or even relevant in the function of Toda's CPU 21.

In view of these discrepancies, Applicant respectfully submits that the proposed combination of references, which would modify Toda's CPU 21 according to Tso's parser 22, would not be made by a person having ordinary skill in the art. All of the pending rejections under § 103(a) rely on this combination. Applicant respectfully submits that at least for this additional reason, the claims are allowable under § 103(a). Accordingly, Applicant requests that the rejections under § 103(a) be withdrawn.

**New claims**

New claims 42-45 have been added. Claims 42-45 depend on independent claim 1, and are therefore allowable at least for the reasons discussed above.

**CONCLUSION**

In view of the amendments and remarks set forth herein, the application and the claims therein are believed to be in condition for allowance and a notice to that effect is solicited. Nonetheless, should any issues remain that might be subject to resolution through a telephonic interview, the Examiner is invited to telephone the undersigned at 512-439-5097.

If any extensions of time under 37 C.F.R. § 1.136(a) are required in order for this submission to be considered timely, Applicant hereby petitions for such extensions. The undersigned hereby authorizes that any fees due for such extensions or any other fee associated with this submission, as specified in 37 C.F.R. §§ 1.16 or 1.17, be charged to deposit account no. 502306.

I hereby certify that this correspondence is being submitted to the U.S. Patent and Trademark Office in accordance with 37 C.F.R. § 1.8 on December 11, 2009 (CT) by being (a) transmitted via the USPTO's electronic filing system; or (b) transmitted by facsimile to 571-273-8300; or (c) deposited with the U.S. Postal Service as First Class Mail in an envelope with sufficient postage addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

/Cyrus F. Bharucha/  
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December 11, 2009  
Date

Respectfully submitted,

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